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20855	7590	04/17/2009	EXAMINER	
ROBINS & PASTERNAK			KELLY, ROBERT M	
1731 EMBARCADERO ROAD				
SUITE 230			ART UNIT	PAPER NUMBER
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			04/17/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/844,662	RASCHKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ROBERT M. KELLY	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 February 2009.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 57,68-71,91 and 96-102 is/are pending in the application.

4a) Of the above claim(s) 91 and 96-102 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 57,68-71 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Applicant's amendment and argument of 2/9/09 are entered.

Claim 57 is amended.

Claims 57, 68-71, 91, and 96-102 are presently pending.

### ***Note: specification citations***

The Examiner will refer to Applicant's specification in terms of the paragraph number of the Application Publication of this Application: Publication No. 2002/0064802, rather than page and line number of the present specification, whenever possible (i.e., the amendments that do not matter to the argument/rejection/objections proffered).

### ***Election/Restrictions***

Claims 91 and 96-102 remain withdrawn as being drawn to non-elected inventions, per the restriction requirement of 4/7/04, response to restriction requirement of 5/10/04, and Official Action of 11/14/06, as well as the prosecution history.

Hence, Claims 57 and 68-71 are presently considered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 7,235,354, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 7,220,719, are withdrawn

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21, 22, and 25-27 of U.S. Patent No. 7,217,509, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,177,766, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 7/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,163,824, are withdrawn.

Specifically, the terminal disclaimer of 7/22/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,097,978 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,070,934, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,067,317, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,045,304, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 7/28/08, the rejections of Claims 57, 68, 70, and 71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7,026,462, are withdrawn.

Specifically, Applicant's terminal disclaimer filed 7/9/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,013,219, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 7,001,768, are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,989,269 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-85 of U.S. Patent No. 6,979,539 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,933,113 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

The rejection of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,919,204 are withdrawn.

To wit, the Terminal Disclaimer filed 9/19/08 has been accepted.

The rejection of Claims 57 and 68-71 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-66 of U.S. Patent No. 6,824,978 are withdrawn.

To wit, the Terminal Disclaimer filed 9/19/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,785,613 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,780,590 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,777,185 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,689,558 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,610,489 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,607,882 are withdrawn.

To wit, the Terminal Disclaimer filed 8/11/08 has been accepted.

As noted in the Advisory Action, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,599,692 are withdrawn.

To wit, the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,534,261 are withdrawn.

To wit the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,511,808 are withdrawn.

To wit the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,503,717 are withdrawn.

To wit the Terminal Disclaimer of 8/11/08 has been accepted.

As noted in the Advisory Action of 8/28/08, the rejections of Claims 57 and 68-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,453,242 are withdrawn.

To wit, the Terminal Disclaimer filed 8/11/08 has been accepted.

***Claim Rejections - 35 USC § 102 - co-invented patents***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

As noted in the Advisory Action of 7/28/08, the declaration of inventorship by Dr. Case, filed on 7/9/08, overcomes the 102(e) rejections against U.S. Patent Nos., and hence, they have been withdrawn in such Advisory Action.

In light of the amendments, the rejections of Claims 57 and 68-71 under 35 U.S.C. 102(e) as being anticipated by each of US Patent Nos.: 7,235,354; 7,177,766; 7,045,304; 6,989,269; 6,785,613; 6,780,590; 6,777,185; 6,599,692; 7,220,719; 7,163,824; 7,013,219; 6,979,539; 6,933,113; 6,824,978; 6,689,558; 6,607,882; 6,534,261; and 6,453,242, are withdrawn.

To wit, there is no teaching to arrive at a specific embodiment claimed presently, only obviousness would lead one to embodiments of three fingers, one being a non-natural helix, and further to being sensitive to DNase I.

***Claim Objections***

In light of the amendments, the objections to Claims 57 and 68-71 for various formalities are withdrawn.

To wit, the claims now clarify the zinc finger domain comprises a non-naturally occurring recognition helix.

***Claim Rejections - 35 USC § 112 - clarity***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In light of the amendments, the rejections of Claims 57 and 68-71 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, are withdrawn.

To wit, it is now clear that the non-natural zinc finger domain is that of the protein, and not the DNA which is recognized.

***Claim Rejections - 35 USC § 112 – new matter rejection***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57 and 68-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for being drawn to new matter. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 57 and 68-71 are complexes in cells, in which a generic zinc finger comprising at least 3 fingers, one of which recognizes a generic non-naturally finger is bound to cellular chromatin in a region sensitive to digestion with DNase I.

There is simply no implicit or explicit description in the original claims and/or specification to demonstrate that Applicant had considered such genera to be the invention.

While there is generic description of modified fingers, recognizing modified sequences, and the use of DNase I digestion (it is noted again this is a non-limitation as the region is so broad as to encompass a whole chromosome), no Artisan could reasonably envision that Applicant interpreted such to be in the invention. The reliance on various portions of the claims and/or specification as originally-filed therefore, only provides support in the form of obviousness. However, obviousness does not supplant the need to disclose to the Artisan the invention in a form that demonstrates possession. Obviousness is not possession.

***Response to Argument – new matter***

Applicant's argument of 2/9/09 has been fully considered but is not found persuasive.

Applicant argues that paragraph 0111 provides support for the invention as claimed, by overcoming the rejection of record (p. 5, paragraph 3).

Such is not persuasive. Paragraph 0111 (the Examiner assumes that the publication is recited, as the original specification does not contain paragraph numbers), simply recites the construction of zinc finger domains which were constructed. Hence, at best, it provides support for the specific domains made, but not the generic embodiments provided, nor the requirement of binding in a region of cellular chromatin that is sensitive to digestion with DNaseI. (It is noted that this limitation contains little relevance to the Art rejections, yet Applicant has claimed it, so they must demonstrate possession of such localization to be found for the specific subset of mutants now claimed.)

Applicant argues that paragraph 0114 provides support for the invention as claimed, by overcoming the rejection of record (p. 5, paragraph 3).

Such is not persuasive. This paragraph evidences that specific zinc fingers were inserted to form specific chimeric proteins, but again fails to evidence possession of the generic embodiments claimed, and further with the localization to a site sensitive to digestion with DNaseI.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In light of the argument, the rejections of Claims 57 and 68-71 under 35 U.S.C. 103(a) as being unpatentable over each of US Patent Nos.: 7,235,354; 7,177,766; 7,045,304; 6,989,269;

6,785,613; 6,780,590; 6,777,185; 6,599,692; 6,453,242, 7,220,719; 7,163,824; 7,013,219;  
6,979,539; 6,933,113; 6,824,978; 6,689,558; 6,607,882; and 6,534,261 alone and/or in  
combination, are withdrawn.

To wit, all patents and the present Application were under assignment to Sangamo  
BioSciences, at the time of the present invention, and as such, under 35 USC 103(c)(1), these  
rejections are properly withdrawn.

### **New Rejections**

#### ***Claim Rejections - 35 USC § 112—new matter and written description***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57 and 68-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to  
comply with the written description requirement and the new matter portion of written  
description. The claim(s) contains subject matter which was not described in the specification in  
such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the  
time the application was filed, had possession of the claimed invention.

Applicant's claims encompass a generic **non-naturally occurring** zinc finger protein  
comprising 3 or more zinc finger domains.

The specification teaches generally to mutate known domains, but does not teach the  
structure of all zinc finger proteins, nor does it teach what mutations are non-naturally occurring.  
Still further, the original claims and the original specification fail to demonstrate any possession

of the genera as claimed. At best, non-naturally occurring amino acids are claimed to be an inclusive genera in the overall genera of the invention (e.g., paragraph 0073 of the Application Publication), however such fails to evince that Applicant possessed only those with non-naturally occurring amino acids, as a genera, much less the larger genera of any non-naturally-occurring zinc finger protein, as the discussion is simply a large laundry list of different types of modifications, and not an evincing of specific possession of any particular genera.

Further, while the Art teaches many zinc finger proteins, the Examiner has been unable to find any evidence that all zinc finger protein structures are known, nor has the Examiner been able to find evidence that there are known structures of zinc finger domains which cannot occur in nature.

Hence, the Artisan could not determine Applicant to have been in possession of such a generic zinc finger protein at the time of filing, and therefore, the claims are lacking proper description.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 57, 68, 70, and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,013,453 to Choo, et al., Patented 11 January 2000, claiming priority to 1994.

Choo teaches, in Example 4, the making of a mutant Zinc finger protein, which has 3 fingers, and binds to the coding sequence for a specific ras mutation which commonly occurs and causes oncogenesis. Choo teaches that the mutant Zinc finger can be used to bind the mutant ras gene in human cells in research (Id.).

Moreover, absent reason to believe otherwise, this site occurs within the broad definition of a general region which is in some way sensitive to digestion with DNaseI.

Hence, the claims are anticipated.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57 and 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,013,453 to Choo, et al., Patented 11 January 2000, claiming priority to 1994, and WO 00/9837755 to Dangl, et al.

Choo teaches making mutant Zinc Finger libraries, which are displayed on the surface of a particle (e.g., ABSTRACT). Choo teaches that such zinc finger libraries may be used to make mutant Zinc finger protein domains that bind novel sequences by screens (e.g., Summary of the

Invention). Such zinc finger proteins can be used to bind genomic DNA (e.g., Id.). Moreover, at least one mutant zinc finger binding domain contains at least 3 zinc fingers (Example 5).

However, Choo does not teach plant cells.

On the other hand, Dangl demonstrates that zinc fingers occur, and regulate pathways (e.g., ABSTRACT). Therefore, it is a truism that zinc fingers also work in plant cells.

Hence, it would have been obvious at the time of invention to modify Dangl's methods and libraries to bind plant genomic DNA, and then utilize such to modify the expression of sequences of DNA. The Artisan would have done so because Choo teaches the ability to do so, and the motivation to study, e.g., point mutations, e.g., from Example 6. Moreover, the Artisan would have a reasonable expectation of success, as Choo teaches that such possible, and Dangl demonstrates that zinc fingers work in plant cells.

Moreover, Applicant is reminded that the breadth of "region" and "sensitive" are so broad as to cause the limitation to have no meaningful significance.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT M. KELLY whose telephone number is (571)272-0729. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M Kelly/  
Primary Examiner, Art Unit 1633